

### **REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks are respectfully requested. By this Amendment, claim 1 is amended. Amended and unamended claims are believed patentable over the Examiner's rejections for the reasons presented below.

#### **Claim Objections under 35 U.S.C. §112**

The Patent and Trademark Office (PTO) rejects claims 1, 3-4, 8-10 and 12-13 under 35 U.S.C. §112, second paragraph, asserting that the claims are indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant amends claim 1 to obviate the rejection thereto. Withdrawal of the rejection to the claims is respectfully requested.

#### **Rejections under 35 U.S.C. §102(b)**

The rejection of claims 1, 10, 12 and 13 under 35 U.S.C. §102(b) over U.S. Patent No. 4,721,294 to *Petersen* is respectfully traversed based upon the amendments to claim 1 that more clearly recite the distinguishing features of Applicant's folding machine.

As amended, claim 1 recites a folding machine comprising a cut-off unit, a processor, a first belt conveyor, and:

a second belt conveyor disposed between said cut-off unit and said processor, the second belt conveyor comprising a variable speed motor and at least one pair of conveyor belts configured to receive the cut sheet conveyed by said first belt conveyor, and convey said sheet to said processor. (Emphasis added).

Applicant respectfully submits that *Petersen* fails to disclose at least the above recited elements of amended claim 1. Specifically, *Petersen* appears to only disclose, at column 6, lines 1+, two conveyor systems having speed V1 and V2 respectively. Between the two conveyor systems is an intermediate belt system having a variable speed based upon free-wheeling shafts 120, coupling 115 and 114, which are driven via roller 119 by belts 99 and 100 at V2. The belts are accelerated by frictional engagement of the paper at the circumference of the roller 118 and travels at V1 only until its end has passed the rollers 116 and 118, (see column 6, lines 30-40). Nowhere does *Petersen* disclose,

teach, or suggest a variable speed motor, as recited in claim 1.

A rejection based on 35 U.S.C. §102 requires every element of the claim to be included in the reference, either directly or inherently. Accordingly, because *Petersen* does not disclose, teach or suggest each and every feature recited in amended claim 1, Applicant's recited feature is distinguished over *Petersen* and therefore a rejection of amended claim 1 under 35 U.S.C. §102(b) is improper. Applicant respectfully submits, therefore, that independent claim 1 is patentable over *Petersen*.

Claims 10, 12, and 13 depend from independent claim 1 and are likewise patentable over *Petersen* at least for their dependence on claim 1 an allowable base claim, as well as for additional features they recite. Withdrawal of the 102 rejection over *Petersen* is respectfully requested.

#### **Rejections under 35 U.S.C. §103(a)**

The Patent and Trademark Office (PTO) rejects claims 1, 8-10, and 13 under 35 U.S.C. §103(a), as obvious over *Reffert* (US 4,491,310) in view of *Vijuk* (US 4,812,195).

As presented *supra*, claim 1 is amended, and as presented below, is believed to be patentable over the alleged combination of applied art for the failure of the applied art to disclose, teach or suggest all of Applicant's recited claim features.

In paragraph 7 of the Office Action, the Examiner appears to admit that *Reffert* fails to teach or suggest a variable speed second belt conveyor. Applicant submits that *Reffert*, at column 7, lines 4-10, supports the fixed difference between the speeds of successive segments 10a and 10b. The Examiner relies upon *Vijuk* to remedy the deficiencies of *Reffert*. Applicant respectfully disagrees and submits that such a combination would render *Reffert* inoperable for its intended purpose.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Reffert*, singularly, provides no such guidance. Although *Vijuk* may disclose a variable belt conveyor, Applicant respectfully submits that it would not

be obvious to one of ordinary skill in the art to use a variable speed drive to control the segment 10b of *Reffert*, as suggested by the Examiner. Segment 10b is not merely a conveyor transporting a work piece from one workstation to another. Segment 10a feeds a cover portion at one speed to be picked up by the faster turning segment 10b, and *Reffert* is configured for both segments 10a and 10b to operate at their maximum and different speeds, a cover sheet being accelerated at the interface between the two segments. There is no need for *Reffert* to employ a variable speed drive for one or the other segments. Indeed, such a combination would adversely affect efficiency of the system even were it to work at all.

Therefore, Applicant submits that the Office Action appears to use improper hindsight reconstruction to pick and choose among isolated disclosures. Accordingly, it is respectfully submitted that claim 1 is patentable at least due to the failure of the Examiner to establish a *prima facie* case of obviousness.

Claims 8-10 and 13 depend from independent claim 1 and are likewise patentable over the alleged combination of references for at least their dependence on claim 1, an allowable base claim, as well as for the additional features they recite.

Accordingly, withdrawal of the 103 rejection is respectfully requested.

### **Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

KANESAKA BERNER & PARTNERS

A handwritten signature in cursive script, appearing to read "Manabu Kanesaka".

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